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Supreme Court of the United States

October Term, 1936

Nos. 35 and 36

SAMUEL B. SMITH, *Petitioner*,

vs.

A. B. HALL and L. C. HALL, d. b. a. HALL BROTHERS,
Respondents,

SAMUEL B. SMITH, *Petitioner*,

vs.

JAMES MANUFACTURING COMPANY and ELMIRA HATCHERIES, INCORPORATED,
Respondents.

OPINIONS OF THE SUPREME COURT OF CANADA INVALIDATING SMITH CANADIAN PATENT ON HASTINGS DEFENSE

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THE KING *v.* THE SMITH INCUBATOR CO. and THE BUCKEYE INCUBATOR CO.	We concur: "L. P. Duff" "H. H. Davis" "P. Kerwin" "A. B. Hudson"

Coram: The Chief Justice, RINFRET, DAVIS, KERWIN and HUDSON *JJ.*

RINFRET, *J.* The Canadian letters patent No. 217,777 issued to Samuel B. Smith on the 18th day of April, 1922, for alleged new and useful improvements in incubators are impeached by the Attorney General of Canada who alleges that the respondents, respectively owner and licensee thereunder, in attempting to enforce their alleged rights granted by the said letters patent, are seriously and detrimentally affecting the welfare of the Canadian poultry industry. The Attorney General is acting under s. 60 of the Patent Act, 1935 (25-26 Geo. V, chap. 32).

The information prays that the letters patent be declared invalid and void and that the same be cancelled and set aside.

In the Exchequer Court, the patent was held valid; and the Attorney General appeals from that judgment.

Several grounds of impeachment set out in the particulars of objection filed with the information were abandoned at the trial. In this Court, the grounds upon which the patent was sought to be impeached were:

> (a) That there was no invention, having regard to the prior art and to the prior knowledge and use of a similar device in the year 1912 by one Milo Hastings, at Muskogee, Oklahoma, U. S. A.;

(b) That the claims of the patent embrace more than the applicant invented, if he invented anything.

The apparatus and method disclosed in the specification is there stated to be

> particularly designed for extensive operations wherein a chamber of large dimensions is adapted to contain thousands of eggs in separate trays arranged in tiers and the method of heating is such that the heated air is adapted to the eggs in various stages of incubation. There is forced circulation of hot air through the chamber which is adapted preferably to maintain all eggs at temperatures between 100° and 105° Fahrenheit approximately and this improved system contemplates that fresh eggs will be placed in a horizontal plane, preferably by means of trays supported in horizontal planes, and after the eggs have been subject to the circulation of hot air for a predetermined time (the air circulating largely around the eggs) they will be placed in a tilted or inclined position in a different location but still subject to the same column of air and at this period of incubation they will be tilted in different planes at regular intervals during the time they remain in this latter position, and after they have remained for a predetermined time they will be again moved to a different position with reference to the forced circulation of hot air and so placed therein that the air will tend to keep the eggs below 105° temperature, and in this last named position the air will in effect act as a cooling medium for the eggs. The temperature of circulating air should be such as will prevent the eggs in the early stage of incubation from falling

> below 100° and the speed of velocity of the circulating air should be such as to carry the heat away from the eggs in the later stage of incubation and thereby hold the temperature of those eggs at 105° or slightly below that. It is manifest that the temperature will remain practically the same throughout the column of the eggs, but the air is impelled with sufficient velocity to carry the heat away from the eggs which happen to be in the advanced stage of incubation.

A detailed description of the apparatus and of its method of work is then given by reference to the figures and numbers on the accompanying drawings.

The "forced circulation of hot air through the chamber" is provided by means of fans, or series of fans of which it is said that they

> can be so arranged and can be operated at such speed as to cause the hot air to circulate fast enough to keep the temperature throughout the chamber between the limits of 100° and 105°.

The specification then goes on:

> It, therefore, appears that the improved apparatus and method contemplates the application of hot air circulating in a column with such speed as to keep the temperature substantially uniform and so arranging the eggs that the fresh eggs are placed at one point in the column of air and held in a horizontal plane until they reach a predetermined stage of incubation and then put at a different point in the same column of air and kept in planes inclined to the horizontal and thereafter placed at such a point in the column of air that the forced draft of air

acts to hold the eggs at a uniform temperature and to prevent them from becoming overheated and thereafter placing the eggs into final position for the hatching operation.

The specification further provides that

> "Any suitable thermostatic means may be employed for regulating the temperature such for instance as a thermostat commonly employed in incubators of a well known construction" etc.

There are five claims. Claims 1, 2 and 3 relate to "the method of hatching". Claims 4 and 5 relate to the apparatus. Claim 1 is typical of the three claims relating to the method; and, for our purposes, it will be sufficient to set it out in full:

> The method of hatching a plurality of eggs by arranging them at different levels in a closed chamber having restricted openings of sufficient capacity for the escape of foul air without undue loss of moisture and applying a current of heated air, said current being created by means other than variations of temperature and of sufficient velocity to circulate, diffuse and maintain the air throughout the chamber at substantially the same temperature whereby the air will be vitalized, the moisture conserved and the units of heat will be carried from the eggs in the more advanced stage of incubation to those in a less advanced stage for the purpose specified.

Whatever difference may exist between this claim and claims 2 and 3 is not material and may be pointed out as we proceed.

The claims relating to the apparatus read as follows:

> 4. In an incubator, a closed chamber having a central corridor provided with an air-distributing space in its upper portion and a power-driven fan in said space, curtains at each side of said corridor, arranged to permit the air to circulate from the bottom of the chamber into the part of the chamber behind the curtains, passageways connecting the air distributing space with the corridor and the part of said chamber behind the curtains, separate stationary and tilting racks behind said curtains, egg trays having open-mesh bottoms removably mounted upon said racks, and means to heat the air circulated through said chamber.
>
> 5. In an incubator, a closed chamber with a vertically disposed partition to provide a corridor having upper and lower passage-ways to said chamber, egg trays arranged at different levels in said chamber, a power driven fan creating a current in said corridor to circulate through said passage ways and egg trays, said chamber having restricted openings of sufficient capacity for the discharge of foul air without undue loss of moisture and means to heat the air circulated through said chamber.

Evidence, including several prior patents and publications, was adduced for the purpose of establishing prior knowledge and the advance of the art up to the date of Smith's alleged invention which, by mutual consent, was agreed as carrying back to the year 1915.

Now, it was in the Fall of 1911 and the Winter of 1912 that Milo Hastings installed and organized a large hatchery at Muskogee, Oklahoma.

Mr. Hastings was here as a witness in the present case. He said he had become "interested in incubation" as early as the year 1896. After graduating from college, he was employed as a poultry man by the United States Department of Agriculture. He was called upon to investigate the cold storage industry of eggs and chickens; and thus he became acquainted of the fact that for the successful storage of eggs and chickens it was necessary to have the control of humidity, as well as of temperature, in cold storage chambers. When working upon the cold storage industry, he noticed the use of fan circulation of air in a chamber to equalize heat and also to control humidity. It occurred to his mind that the essential problem of incubation upon a large scale involved the same series of natural conditions and natural laws, the circulation of air, the equal distribution of heat and humidity; and that if, by means of a fan, he could equalize the temperature of eggs when holding them cold, the same thing could be done for an incubator with the same large room structure and superimposed trays. He developed that conception while working for the Department of Agriculture as a poultry expert during the year 1908. He described in a rough and general way what he considered his invention in a book entitled "THE DOLLAR HEN", which was copyrighted in the year 1909. In the early winter months of 1911, he built an incubator along the lines of his conception for Mr. Walter D. Davis, of Brooklyn, and he operated it during the hatching season, in the Spring of 1911. The total capacity of this incubator was 6,000 eggs. In this incubator, he used a fan for the circulation of air.

This first attempt of Mr. Hastings to reduce his conception to practice need not however be developed, as it is not relied on by the Attorney General. We may pass at once to the Muskogee plant, in respect to which alone after

prior user is alleged as defeating the validity of the respondents' patent.

The room-sized incubator at Muskogee was erected, as already mentioned, in the late Fall of 1911 and the early Winter of 1912. It was operated by Hastings during the hatching season of 1912. The construction of that hatchery was explained in detail by Hastings. He filed three diagrammatic drawings of the incubator which he built and operated. They show a series of seven incubating chambers all contained in a single room. At one side of the chambers is a corridor into which they open and from which the eggs enter, the chickens are taken out, etc. A panel door is set up, not hinged but buttoned, in front of each hatching chamber when the operator is not working it. An entry way leads into the corridor from which the chambers are worked. A fan or blower is provided for air circulation through a passageway over the incubating chambers leading to the chamber where the heater is located. The air rising through this chamber, impelled by the pressure from the fan or blower, goes into another large opening at the top of the seven incubating chambers, the air is driven by the impulsion of the blower or fan down through the incubating chambers into a passageway which is merely an opening along the floor. The air is then drawn by suction to the fan or blower from which the circuit is repeated indefinitely. The hatching or incubating chambers are made to contain screen bottom trays with special millwork slides. In each chamber there is room for twenty trays; each tray has a capacity of 250 eggs; which gives 5,000 egg capacity for the chamber, or 35,000 capacity for the whole plant of seven chambers.

Although seven incubating chambers are shown, it was one hatching operation all carried on in the same room.

Hastings testified that the diagrams produced by him correctly showed the hatchery actually in use and operated by him at Muskogee. Ventilation, he stated,

> was definitely assured by the fact that the heater has a gas flame burning in the bottom of a vertical pipe; and to support its combustion it has to draw and consume a steady stream of air.

He made provision for controlling the moisture; and

> the eggs were turned as the art required; in this case, they were turned by hand.

Hastings admits he did not distribute the eggs in any particular way; but, being skilled in the art of incubation and being aware of the fact that the eggs, in the early stages of incubation, absorb heat (or they are endothermic), while, in the later stages, they generate heat (or they are exothermic), he knew that the heat or the temperature of the eggs was "a factor of conductivity from the circulating air". He declares positively that

> observing that he would naturally place his eggs as they were in the various stages so that he did not have too many eggs in the latter stages of incubation in one general mass.

In his own words: his

> fundamental invention had been to equalize the air in a large hatchery by the forced draft or fan system of circulating the air.

He explains the conception of his invention was "to equalize the temperature in a large room" through the means adopted and used by him.

Hastings hatchery was open to the public. It was extensively advertised; and there was no attempt to keep secret any detail of construction or operation.

Of course, it must be admitted that Hastings' enterprise did not meet with financial success. He attributed that to two particular factors; the low cost at which the hatching was done; and the incidental expense of a new and untried venture.

Be that as it may, commercial success may be due to many factors. The reasons given by Hastings for the failure in the present case seem plausible; and the evidence here

> "cannot afford a basis for refusing to give effect to the conclusion necessitated by the facts". (Guettler v. Canadian International Paper Company, 1928 S. C. R. 438).

As observed by Parker, J., in Robertson v. Purdey (24 R. P. C. 273, at p. 299):

> If I am satisfied that the evidence of prior user is trustworthy evidence, I am not at liberty to disregard it merely because the prior user was not attended with any commercial success, more especially if the want of such success can be otherwise explained.

In this case, we have no reason to decide that Hastings' evidence was not trustworthy. We are not unaware of the principle that evidence of prior user should be subjected to the closest scrutiny and that it should not be accepted without the greatest caution. But Hastings' description of his apparatus and his story of his method of operation is corroborated by the witness Norman Hickox, who visited the

Muskogee hatchery at the time it was in use, took photographs of it, and wrote an article about it early in 1912. The photographs and a photostatic copy of the article are filed in the case. It is reasonably evident from the description contained in that article that Hastings' conception, in the form testified to by him at the trial, was reduced to practice, as he outlined it, in the Fall of 1911; and that his operations at Muskogee carried out the idea of forced circulation of air and of staged incubation.

To our mind, this is definitely supported by the language used in the brief on the appeal to the Examiners in Chief, when Hastings' application for a patent was filed on May 3rd, 1911, in the United States Patent Office. The conception claimed by Hastings in the course of his evidence was implicitly disclosed in the specification written by himself to accompany his original application (dated April 20th, 1911). It is expressly stated in the brief to the Board of Examiners in Chief on appeal (December 20th, 1912), where Hastings developed his ideas; and, among other, used the following language:

> The problem has been to enable the incubating operations to be carried on continuously, if so desired, with eggs at all stages of development, and with all of a vast number of eggs subjected to the same temperature and atmospheric conditions best adapted for the development of the embryo. An incubator such as is contemplated is in sharp contrast to the ordinary incubator in that it is designed to handle simultaneously hundreds of thousands of eggs and, therefore, requires a relatively large chamber for accommodating them.

The documentary evidence in the record—evidence writings and publications contemporaneous with Hastings' user—constitutes the most satisfactory corroboration of Hastings' testimony in this respect. In fact, it was believed by the trial judge and it was accepted by him. His judgment proceeds on the assumption that Hastings' evidence is true; and he found the Smith patent valid only because, in the view he took of the situation, there was some slight difference between Smith's conception and Hastings' conception. This difference the learned judge described as consisting

> "in the manner in which the air is driven and circulated through the egg chambers in the Smith's incubator" and "to a lesser degree, in the arrangement of the tilting racks whereby the eggs may be turned conveniently and with a considerable saving of time and labor".

But, of course, the subject-matter of Smith's alleged invention and the validity in that respect of the patent in suit must of necessity be envisaged within the ambit of the claims accompanying the specification.

There are, as we have pointed out, what may be called the method claims and the apparatus claims. Of the former, claim No. 1 has already been set out. There is no material difference between it and the other two method claims. The only change consists in substituting a slightly differently worded definition of the "current of heated air". In claim No. 1, the phraseology runs thus:

> applying a current of heated air, said current being created by means other than variations of temperature.

In No. 2:

> applying a power driven current of heated air in an adjacent chamber through openings into the egg chamber.

In No. 3:

> applying a vertically directed current of heated air in an adjacent chamber to circulate in said egg chamber through upper and lower openings between said chambers.

Otherwise, the three claims are verbatim the same.

Now, as observed in the judgment appealed from,

> "the principle of air circulation in a room to maintain uniformity of temperature is not new".

The invention, if any, cannot consist in the adoption of this principle. In order to reveal the exercise of the inventive faculties and thereby to bear the character of an invention in the patentable sense (Crosley Radio Corporation v. Canadian General Electric Company, 1936 S. C. R. 551, at p. 556), it would not be sufficient for Smith's conception to consist in the adoption of the principle of air circulation in a room for the purpose of maintaining in it uniformity of temperature. It would require a further step, to wit, a novel method of utilizing air circulation involving "a degree of ingenuity • • • which must have been the result of thought and experiment". (Lord Watson in Thomson v. The American Braided Wire Co., (1889) 6 R. P. C. 518).

Now, if the claims in the patent in suit be examined, the first characteristic therein to be noticed is that nowhere is there claimed precisely as material any particular method of utilizing the air circulation, except, perhaps, the statement that the current of heated air is "created by means other than variations of temperature".

This was pointed out, and indeed insisted upon, by the Supreme Court of the United States, in the case of Smith v. Snow (Jan. 7, 1935, 294 U. S. R. p. 1) where

> only so much of the patent as relates to a method for incubation

was involved; and the only question presented was

> What scope may rightly be given to claim 1 of the patent?

The opinion of the Court was delivered by Mr. Justice Stone; and, in the course of his judgment, the following statements occur:

> Moreover, while the specifications and drawings show a particular arrangement of the eggs and a particular direction of the current, nowhere in specifications or claim, is it stated either that the direction of the current is material or, what is the equivalent, that the order in which it reaches the eggs is material.
>
> • • • The specifications and claim both contemplate a continuous circulation of the current of heated air through the chamber, which, regardless of its direction, would continuously operate, by repeated contacts with the eggs in all stages, to equalize the temperature throughout the chamber by carrying heat units from the warmer to the cooler eggs (p. 12).
>
> • • • Such continuous circulation of the air at constant temperature, lower than that of the more advanced eggs and higher than that of the less advanced, tends to produce the equalization of the temperature of the eggs by flow of heat units from the warmer eggs to the cooler, regardless of the direction

> of the current in the circuit, and regardless of the particular stage of the eggs which it reaches first. * * *
>
> It is evident that Claim 1 does not prescribe that the current of air shall be propelled by any particular means, except that it shall be by means other than variation of temperature, nor does it prescribe that the means of propulsion shall be given any particular location, or that the current of air shall be guided by any particular means or given any particular direction (p. 13).

In the judgment, these statements in regard to Claim 1 are subsequently qualified by pointing out that the other claims of the patent (N. B. Meaning, no doubt, No. 4 of the apparatus claims) speak, in particular, of the power driven fan and of curtains.

> arranged to permit the air to circulate from the bottom of the chamber into the part of the chamber behind the curtains;

but that refers only to the structure of the apparatus. The arrangement, so it is claimed, is only "to permit the air to circulate from the bottom". Nowhere is it prescribed as an essential integer of the claimed invention that the eggs should be placed in any particular order in the incubator,

> or that the propelled current should reach them in any particular order (p. 14).

The conclusion of the United States Supreme Court on that feature of the case was that there was nothing in Claim 1

> to restrict the patent to any particular order of arrangement of the eggs or any particular direction or means of control of the current of air, other than its velocity, and nothing to estop the patentee from asserting that the claim is not restricted by such features (p. 16).

This conclusion, with which we agree, is, in our view, decisive in respect to the main ground upon which the learned trial judge based the validity of the respondents' patent; for what was said of Claim 1 by the United States Supreme Court is also true of the other claims; and it follows that, having regard to Milo Hastings' operations and prior public use in Muskogee, as established in the present case, Smith's claims in the patent in suit are obviously too wide.

In Smith v. Snow, Claim No. 1 was held valid by the Supreme Court of the United States; but it was distinctly stated that it was upheld on the ground that Smith

> was the first to apply mechanically circulated currents of air to eggs • • • arranged • • • in staged incubation.

It was said that he had

> thus solved the major problem of artificial incubation by replacing "the old type of incubation with eggs arranged at a single level while in a single stage of incubation".

But it was also stated that the question whether "it was invention (was) not seriously disputed here" and "that the method employed in the Smith type of incubation was novel and revolutionary in the industry (was) not challenged".

This was as between Samuel B. Smith and E. H. Snow in the particular case presented to the Supreme Court of the United States. In that case, Hastings was not a witness, nor was there any evidence of what his prior use had been. The judgments of the Supreme Court of the United States carry the greatest weight and are entitled to the greatest respect. But because the record now before us is so widely different from the record in Smith v. Snow, we feel that the conclusion reached by us must also be different. Indeed, and more particularly in view of the opinion delivered by Mr. Justice Stone on behalf of the Court, we are led to believe that had the prior public use of the patented method and knowledge thereof by Milo Hastings been adduced in evidence in the Snow case, the result would have been different.

We may add that our view in that respect is shared by the United States Circuit Court of Appeals for the Second Circuit in Smith v. Hall, which is the most recent judgment on the question at issue and where it is stated:

> This is the first time the prior uses at the Davis Place and at Muskogee have been so fully presented and substantiated.
>
> On the record now before the court, it is impossible to agree that Smith's discovery was not known or used by others in this country before his invention or discovery thereof.

What was said of the situation in the United States in the latter judgment equally applies to Canada as the law stood at the time when the disputed patent was issued.

What are, after all, the essential features of the invention contended for by Smith as he has himself expressed them in his claims:

(1) A method of hatching a plurality of eggs

(2) By arranging them at different levels

(3) In a closed chamber

(4) The chamber having restricted openings of sufficient capacity for the escape of foul air without undue loss of moisture; and

(5) Applying a current of heated air

(6) Said current being created by means other than variations of temperature (or—claim 2—"power driven in an adjacent chamber through openings into the egg chamber"; or—claim 3—"being vertically directed in an adjacent chamber to circulate in the egg chamber through upper and lower openings between said chambers");

(7) The current of air being of sufficient velocity to circulate, diffuse and maintain the air throughout the chamber with substantially the same temperature;

(8) Whereby the air will be vitalized (i. e. a process of ventilation);

(9) The moisture conserved;

(10) And the units of heat will be carried from the eggs in the more advanced stages of incubation

to those in a less advanced stage for the purpose specified.

We have the large capacity, the eggs at different levels in a closed chamber, the circulation of air created by means other than variation of temperature (the fan or the blower), the ventilation, the moisture and the staged incubation—all present in Hastings' prior use and venture and all reading into the claims as they were expressed and made by Smith. We are not asking ourselves for the present whether there were divergences between Hastings' public use and practice and Smith's actual method. We are taking Smith's method as he has claimed it and we are forced to the conclusion that undoubtedly, as expressed, the claims are too wide and the greater part of them, if not all, was already anticipated and precluded by Hastings' public use.

So far as the apparatus claims are concerned, it is doubtful if, standing alone and independently of the prior knowledge and prior user, they would have been regarded as sufficient in themselves to support a grant of letters patent. But we would say that upon the evidence in this case we do not find it possible to declare that the advance, if any, can be regarded as good and sufficient subject-matter of a patent. The closed chamber, the corridor provided with air distributing space in its upper portion, the power driven fans, the partition between the air distributing spaces and the egg chambers, the passageways, the egg trays with mesh bottoms removably mounted upon racks and means to heat the air circulating through the adjacent chamber were

all present in Hastings' user and method. No particular claim is made by Smith for "the arrangement of the tilting racks" which the learned trial judge found subject-matter to a lesser degree than the main point concerning the method of utilizing "the air driven and circulated through the egg chambers in the Smith incubator".

Any difference that might exist between the Smith structure and the Hastings structure consists only in mechanical details. So far so that it would seem to us that had Hastings been successful in securing a patent for his structure as described in the evidence in this case, claims 4 and 5 of Smith's patent would be regarded as infringements. And, of course, the reverse conclusion follows that Smith's claims 4 and 5, coming, as they do, several years after it, are defeated by Hastings' prior public use.

A fortiori, claims Nos. 4 and 5 ought to be regarded as invalid and void as embracing more than Smith could claim as new; and, indeed, as claiming something which, having regard to the prior public use of Hastings, did not amount to an invention in the pertinent sense.

The appeal must, therefore, be allowed with costs both here and in the Exchequer Court of Canada. The information of the Attorney General of Canada shall be maintained and there will be a declaration that the letters patent No. 217,777 issued to Samuel B. Smith, on the 18th day of April, 1922, are invalid and void and that the same are cancelled and set aside.

SMITH INCUBATOR COMPANY *v.* ALBERT SEILING.	We concur: "L. P. Duff" "H. H. Davis" "P. Kerwin" "A. B. Hudson"

Coram: The Chief Justice and RINFRET, DAVIS, KERWIN & HUDSON, *JJ.*

RINFRET, *J.* This is an appeal from the judgment of the Honourable Mr. Justice Angers, in the Exchequer Court of Canada, dated the 29th day of January, 1936, dismissing the appellant's action for an injunction and damages for the infringement of its patent No. 217,777. The patent involved is the same as was considered in the judgment of this Court in the case of His Majesty the King v. Smith Incubator Company, delivered at the same time as the present judgment.

So far as it applied, the whole of the evidence in the former case was made part of the evidence in the present case. The issue in respect of the validity of the appellant's patent must, therefore, follow the decision in The King v. Smith Incubator Company.

In his judgment, the learned trial judge in this case did not pass upon the validity of the patent already upheld by him in the judgment in the other case. But, having formally held that

> the only element of novelty in the Smith's patent, as set forth in the (former) case, is the method of circulating the hot air in the incubator and the method of turning the eggs periodically during the incubation process,

he found that the method in this respect used by the defendant was quite different; and, accordingly, he failed to see any infringement by the respondent.

The Smith patent having been held invalid by our judgment, delivered upon the information of the Attorney General of Canada, it become unnecessary for us to pass upon the issue of infringement. It should only be stated that the respondent Seiling himself holds a patent covering his incubator (Canadian Patent No. 310061); and, had there been occasion for it, we would not have been prepared to decide that his patent infringes that of the appellant.

However, for the reasons already stated in The King v. Smith Incubator Company, patent No. 217,777 must be declared invalid and void and must be set aside. As the patent is the only ground upon which the appellant can claim infringement, the foundation for his action is thereby removed; and we must decide, therefore, that the action was rightly dismissed by the learned trial judge.

In view of this result, there remains no longer any necessity of discussing at length the appellant's contention that:

> There are two separate lines of authority suggesting what are • • • mutually inconsistent attitudes towards • • • the definition of the scope of a patent monopoly in the patent claims.

The appellant proceeds:

> According to one of these it is proper to consider what is 'the pith and substance' or the 'spirit' of the invention and to give effect to the patent accordingly. The other is to regard the claims as definitely determining the scope of the monopoly which the patent purports to grant and to give or refuse them effect

> according to the expressions they contain when these expressions are properly construed and their meaning determined.

In our view, the rule is that the claims must be regarded as definitely determining the scope of the monopoly, having regard to the due and proper construction of the expressions they contain. Such was the direction given and the rule followed by this Court in Mailman v. Gillette, 1932 S. C. R. 724; Gillette v. Pal, 1933 S. C. R. 142; Burt v. Autographic, 1933 S. C. R. 230; and Schweyer v. N. C. R., 1935 S. C. R. 665. and, notwithstanding the suggestion to the contrary, such was also the rule applied in Electrolier v. Dominion Manufacturers, 1934 S. C. R. 436.

As often observed, of course, the claims must be construed in the light of the rest of the specification; and that is to say that the specification must be considered in order to assist in comprehending and construing the meaning—and possibly the special meaning—in which the words or the expressions contained in the claims are used (Ingersoll v. Consolidated, (1907) 25 R. P. C. 61, H. L. at p. 82). But, as was said in the Electrolier case (1934 S. C. R. 436, at p. 442),

> infringement is a matter depending on the construction of the claims, for there it is that the inventor is required to state "the things or combinations • • • in which he claims an exclusive property and privilege."

Generally speaking, actions for infringement are met with two distinct defences; one being that the plaintiff's patent is invalid; the other being that, whether the plaintiff's patent is invalid or not, the defendant does not in-

fringe. And it may be that, to borrow the words of Frost (Patent Law and Practice, 4th Ed., Vol. 1, p. 349), "the criterion of novelty and infringement in this respect are not the same." But, in each case, the criterion must be determined according to the scope of the monopoly as expressed in the claims; although it is not necessary, to justify a holding of infringement, that the infringing article should be found identically, or in every respect, the same as the plaintiff's patented article. It is sufficient if the infringer has borrowed the substance or spirit of the invention as it can be ascertained from the claims, except in details which could be varied without deteriment to the successful working of it.

The appeal is dismissed with costs.